

REMARKS

Claims 43-55 (less than 15 claims) are pending in this case. The Examiner has proposed restriction into two groups:

Group I (claims 43-49, drawn to a method of generating a synthetic sales history, classified in class 705, subclass 10).

Group II (claims 50-55, drawn to a method of generating and improving a synthetic sales history, classified in class 705, subclass 10).

Interview Summary

Applicants express their appreciation to Examiner Pats and SPE Boswell for the courtesy of an interview held in Ms. Boswell's office on September 24, 2008 at 3:00 p.m. During the interview, we discussed wording of the claims and the pending restriction requirement. The claims describe a method that includes initially selecting a candidate good from which to copy a sales history and create a synthetic sales history for a new good. The method continues with analyzing actual sales performance and modifying the initial candidate good selection, either by rescaling the sales history of the candidate good to adjust the synthetic sales history (claim 43) or by selecting a different good from which to copy a sales history and create a synthetic sales history (claim 50). After discussion, the Examiners seemed satisfied that the wording of the claims was clear.

We also discussed the lack of *prima facie* support for the restriction requirement. On page 4 of the restriction requirement, the Examiner used a form supplied by the PTO's computer systems. We learned during the interview that the Examiners were instructed to use this boilerplate form without selecting among the five reasons that are offered in the alternative and without any providing evidence to support any of the five reasons. This is the second restriction requirement which counsel has responded to in the last month that used the form paragraph indiscriminately, as reproduced on the following page.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include

Applicants' position was that the Examiners are required to know and understand law and to interpret guidance and apply available forms consistent with the law. The law never allows an Examiner to say "because one or more of the following [five] reasons apply", without providing any evidentiary support for application of any of the alternative reasons. The form paragraph that the PTO software encourages Examiners to use is fatally defective because it leaves the applicants wondering what, if any, basis the Examiner has for believing that a serious search and examination burden would result if a restriction were not required. The form paragraph always fails to prove a prima facie case, because it does not require the Examiner to provide evidence supporting whichever basis the Examiner imagines should apply to the case at hand.

Deputy Commissioner Love has been very clear in remarks that each Examiner is responsible for understanding and following the law, using guidance and advice from other personnel to help them and not as a substitute for careful analysis or for following the law.

The Examiners encouraged us to clearly state our objection to this practice, so that they could circulate our comments.

Provisional Election, Effective Upon Final Restriction Requirement

Effective upon imposition of a final, petitionable restriction requirement, Applicants elect Group 2, claims 50-55. This provisional election is accompanied by the

traversal below. It is expected that an analysis of the art of record will require reunification of the claims, upon allowance, if the Examiner persists in the restriction requirement.

Traversal

The Examiner has applied the wrong standard to justify a three-way restriction requirement and the Examiner's rationale is so generic as to preclude meaningful review.

Two-Way Distinctness Not Proven

The Examiner has not correctly cited the current requirements of MPEP § 806.05, at 800-44 (8th Ed., Rev. 5 Aug. 2006). The Examiner omitted mention of the so-called "two-way distinctness" test and did not supply a rationale that would satisfy this demanding test. The current provisions of §§ 806.05 and 806.05(c) read, in part:

See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a **two-way test is required** for distinctness.

806.05(c) Criteria of Distinctness Between Combination and Subcombination [R-5]

To support a requirement for restriction between combination and subcombination inventions, **both two-way distinctness and** reasons for insisting on restriction are necessary, i.e., there would be a ***serious< search burden >**if restriction were not required< ...

The inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in another materially different combination.

There is no mention or application of the **two-way distinctness test** in this restriction requirement. Therefore, the Examiner has failed to satisfy the first prong of the test for restricting claims. The restriction requirement should be withdrawn.

Serious Burden Not Proven

The Examiner has given criteria that the Examiner believes would prove a serious burden (*compare* MPEP at 800-53), but has not applied those criteria to the identified Groups 1-2 of claims. What the Examiner wrote could be inserted into any restriction requirement without changing a single word. This kind of generic wording has

nothing to do with this particular application and does not afford any basis for review by petition:

and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The evidence in the restriction requirement points away from any serious burden, as both claim groups have the same classification, in 705/10. Moreover, there is significant overlap between independent claims 43 and 50. Both claim a method that includes initially selecting a candidate good from which to copy a sales history and create a synthetic sales history for a new good. The method continues with analyzing actual sales performance and modifying the initial candidate good selection, either by rescaling the sales history of the candidate good to adjust the synthetic sales history (claim 43) or by selecting a different good from which to copy a sales history and create a synthetic sales history (claim 50). Five of six elements in the claims have the same words. Claim 43 complements claim 50, because a new rescaling factor will have to be calculated (as in claim 43) if a new good is chosen to supply a synthetic sales history and the rescaling factor will be based on the actual sales history of the new good. That is, claim 50 could readily be restated as dependent on claim 43.

Our review of the proposed groups convinces us that the serious search burden cannot be met, when the claim sets are examined. The Examiner needs to search for art that matches the first four steps, when searching both Group 1 and 2. If any art is found that matches the first four steps, it may offer the correction of claim 43 of claim 50

or of both. But one cannot search for the correction step by itself – the search always involves searching for the first four steps. Moreover, we cannot imagine any manner of searching Group 2 that would not provide a complete search of Group 1.

Because the Examiner has failed to satisfy either the first or second prong of the two-prong test, the restriction requirement should be withdrawn.

Related Processes is More Applicable than Combination / Subcombination

Groups 1 and 2 should be considered “related processes” under MPEP

§ 806.05(j), which provides, in part:

For other related ... related process inventions, the inventions are distinct if

(A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;

(B) the inventions as claimed are not obvious variants; and

(C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

The burden is on the examiner to provide an example to support the determination that the inventions are distinct

A review of the claims indicates that Group 1 is related to, rather than a subcombination of elements in Group 2. Or, if it is a subcombination of Group 2, there is not any two-way distinctness and there is substantial overlap.

For the many reasons given, the restriction requirement should be withdrawn.

Request for a Further Interview

When the Examiner has completed a further search, we request a courtesy telephone call with the search results and an opportunity to bring the application into condition for allowance.

CONCLUSION

Applicants respectfully submit that the pending claims distinguish over the art of record in this and the several related cases that Examiner Boswell has examined.

Applicants look forward to a further interview, if the Examiner is not yet ready to allow the case. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Fee Authorization. The Commissioner is hereby authorized to charge underpayment of any additional fees or credit any overpayment associated with this communication to Deposit Account No. 50-0869 (BLFR 1002-1).

Respectfully submitted,

/ERNEST J. BEFFEL, JR./

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